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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No. : 09/821,195
Applicants : Timothy C. Loose
Wayne H. Rothschild
Norman R. Wurz
Filed : March 29, 2001
Title : Gaming Machine With An Overhanging Touch Screen
TC/A.U. : 3712
Examiner : Mosser, Robert E.
Docket No. : 47079-00086
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Signature (Deborah Ricks)

Commissioner for Patents
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REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.37

Dear Sir:

This Reply Brief is filed responsive to the Examiner's Answer mailed on February 1, 2007. The due date for this Reply Brief is two months from the mailing date of the Examiner's Answer and this paper is being timely filed on Monday, April 2, 2007, within that time period.

ARGUMENT

Appellant respectfully submits that the Examiner did not discharge the initial burden of establishing a *prima facie* basis to deny patentability to the claimed invention for want of the requisite facts and motivation to combine the applied references in the manner asserted. Appellant respectfully submits, further to the remarks presented in the previously-submitted Appeal Brief, the following remarks responsive to the Examiner's Answer.

1. CLAIMS 1-3 AND 5-9 ARE PATENTABLE UNDER 35 U.S.C. §103(A) IN VIEW OF THE COMBINATION OF SAFFARI AND BRUZZESE

A. THE COMBINATION OF SAFFARI AND BRUZZESE FAILS TO TEACH AND SUGGEST EACH AND EVERY ELEMENT OF THE CLAIMS

In the Examiner's Answer, the Examiner states that "Appellant provides no support within the reference of Saffari to substantiate their interpretation of the prior art of Saffari with their statement "[t]he touch-sensitive portions 322a, 322b, 322c, disclosed by Saffari and noted by the Examiner are not in a video portion of the display 302" (*see* page 8 of Appeal Brief).

Appellant submitted that Saffari does not disclose or suggest, for example, the claimed video portion including player-selectable first indicia selectable via the unitary touch screen. In this regard, Appellant argued that the touch-sensitive portions 322a, 322b, 322c, disclosed by Saffari and noted by the Examiner were not in a "video portion" of the display 302 and that the only "video portions" of the display 302 disclosed by Saffari appeared to include the symbol positions of rows 312a-c, columns 304a-c and perhaps timer 310. It bears emphasizing that the Appellant was not attempting to argue that Saffari does not disclose a "video display," as appears to have been the interpretation of the Examiner. Saffari does disclose a video display 302.

In the Appeal Brief, Appellant was merely drawing the distinction that a portion of the video display was being utilized for touch screen buttons 322a-c or indicia 522a-c rather than

“player-selectable first indicia,” as claimed. The Appellant was further trying to draw the distinction that the video portion itself includes “player-selectable first indicia.” In fact, the Examiner’s statement of rejection does not even allege that Saffari disclose or suggest such “player-selectable first indicia.” Instead, the Examiner alleged that Saffari “displays a plurality of symbols indicating a randomly selected outcome of a wagering game and a separate non-video-portion further including permanent second indicia (Saffari Elm 522, 523, Figure 5, & Col 3:2-5)” and that “[t]he video portion further contains an integrated touch screen display and player selectable indicia (Saffari Col 3:24-34; Col 4:21-27; Col 2:62-3:2, Elm 312)”. By inference, the Examiner appears to allege that the display of “a plurality of symbols indicating a randomly selected outcome of a wagering game” itself suffices as the claimed “player-selectable first indicia.” Such position would be facially improper as the recited “player-selectable first indicia” are selectable.

Even if the Examiner were to assume, rightly or wrongly, that the recited “player-selectable first indicia” was not clearly defined by Appellant in the specification, the Examiner would still be required to give the recitation its plain meaning in ascertaining claim scope. In other words, such words in the claim must be read as they would be interpreted by those of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 218 USPQ (Fed. Cir. 1983). The “broadest reasonable interpretation” of the claims permitted by law must be consistent with “the interpretation that those skilled in the art would reach.” *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). In this vein, “[c]laims are not to be read in a vacuum, and limitations therein *are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation’.*” *In re Marosi*, 710 F.2d 799, 802, 218 USPQ 289 (Fed. Cir. 1983)(*italics added*). Appellant respectfully submits, therefore, that one skilled in the art would

not have reasonably interpreted the randomly selected outcome of the wagering game to correspond to the recited “player-selectable first indicia” in view of the specification (*see, e.g.*, page 5, line 2 to page 6, line 23; FIGS. 1, 3).

B. Bruzzese Teaches Away From The Proposed Combination of Saffari and Bruzzese

The Examiner incorrectly asserted that the issue of “bodily incorporation” was raised and then insinuated that Applicant’s quotes taken from Bruzzese were somehow taken out of context (and were therefore misleading)(*see* pages 10-13 of Examiner’s Answer). Substantively, the Examiner stated that “disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments” and took the position that “Bruzzese never prohibits the use of a unitary touch screen with a video display” (*see* page 13 of Examiner’s Answer).

As acknowledged by the Examiner, Bruzzese “broadly provides a mechanical spinning reel gaming machine that incorporates touch screen controls” (col. 1, lines 41-43). Combined with Bruzzese’s statements against touch screens (col. 1, lines 25-36), Applicant’s remarks regarding Bruzzese’s teaching away were certainly not improper. The Examiner makes much ado about the disclosure of video reels being well known, even underlining such text (*see* page 11 of Examiner’s Answer). However, despite the Examiner’s heightened emphasis of this point, the Examiner has failed to properly characterize this disclosure. Bruzzese relegates the disclosure of video monitors/reels to the “Background of the Invention.” In the “Background of the Invention,” Bruzzese does not disclose the video monitor/reels as a “nonpreferred embodiment,” as is being alleged by the Examiner. Instead, Bruzzese discounts such technology entirely in favor of the invention disclosed in the balance of the patent.

Bruzzese indeed discloses that “[g]aming machines that utilise a video monitor to graphically represent the spinning reels also are well known” and that “[s]uch gaming machines similarly incorporate pushbutton controls, although more recently provide for touch screen control by means of controls bonded to the outer surface of the video monitor” (col. 1, lines 25-30). Bruzzese continues on to state that “[t]here are difficult technical problems associated with bonding touch screen controllers to curved video monitor screens, requiring the use of packing materials at the edge margins and sophisticated data processing techniques to ensure a regular array of touchable screen ‘points’ and linearity between such points.” (col. 1, lines 30-36). Bruzzese then states that “[e]ven though video gaming machines utilise more technologically advanced component parts, there still is a significant demand amongst players of gaming machines for the older-style spinning reel machine” and that “[t]he present invention broadly provides a mechanical spinning reel gaming machine that incorporates touch screen controls” (col. 1, lines 30-36)(emphasis added). Bruzzeses’ own pronouncement that his invention “broadly provides” a mechanical spinning reel gaming machine that incorporates touch screen controls, particularly taken in context of his preceding statements (1) against video-based games and (2) in favor of mechanical-reel games, and taken together with the fact that Bruzzese does not mention “video monitor,” “video gaming machines” or “video reels” in any portion of the application other than the “Background of the Invention,” clearly show that the video monitor is not a “disclosed example [of the invention]” or a “nonpreferred” embodiment of the invention.

The Examiner invokes *In re Susi* for the proposition that “disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments,” 440 F.2d 442, 169 USPQ 423 (CCPA 1971). However, the appellant in *In re Susi* was trying to argue, in essence, that the applied reference (Knapp) taught

away from his invention because the formula set forth in the discussion of Knapp was referred to as a subclass noted as his “*most* particularly preferred embodiment” (emphasis added), while the subclass that was closer structurally to the appellant’s additives were merely within the “particularly preferred” class. The CCPA stated that “[w]e cannot accept the suggestion that one is significantly ‘taught away’ from a ‘particularly preferred embodiment’ by the suggestion . . . that something else may be even better.” *Id.* at 446. Thus, the CCPA quite understandably held that a “most particularly preferred embodiment” would not constitute a “teaching away” from a disclosed a “particularly preferred embodiment” in accord with 35 U.S.C. § 103. Appellant therefore respectfully submits that the Examiner’s invocation of *In re Susi* is improper, if not misleading. Appellant’s remarks concerning Bruzzese’s evidence of teaching away was not between a “particularly preferred embodiment” or a “more particularly preferred embodiment,” but rather between that which Bruzzese disclosed as his invention and that prior art that Bruzzese used as a foil to particularly highlight the improvements and advantages of his invention. In this context, Appellant respectfully maintains that Bruzzese teaches away from the Examiner’s proffered combination for at least the reasons previously presented.

It is not simply enough for the Examiner to find that the references teach or disclose known elements. “[I]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.” *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); *see also In re Mercer*, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975). Instead, Appellant respectfully submits that *prima facie* obviousness based on a combination of references requires that the prior art provide “a reason, suggestion, or motivation to lead an inventor to combine

those references.” *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). The Examiner argues in response that, in relation to *In re Susi* and *In re Gurley*, “the art of Bruzzese *never prohibits* the use of a unitary touch screen with a video display” (see sentence bridging pages 12-13 of the Examiner’s Answer)(emphasis added). Appellant respectfully submits that non-obviousness inquiry focuses not what is never prohibited, but rather what would have been obvious to one of ordinary skill in the art at the time of Appellant’s invention. “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.” *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). In determining whether the claimed invention is obvious, a prior art reference must be read as a whole and consideration must be given where the reference teaches away from the claimed invention. *Akzo N.V., Aramide Maatschappij v.o.f. v. United States Int’l Trade Comm’n*, 808 F.2d 1471, 1481, 1 USPQ2d 1241, 1246 (Fed. Cir. 1986).

C. INDICIUM OF NONOBVIOUSNESS

Appellant previously submitted that the problem addressed and solved by a claimed invention must be given consideration in resolving the ultimate legal conclusion of obviousness under 35 U.S.C. §103. See, e.g., *Ecolchem Inc. v. Southern California Edison, Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990).

In response to Appellant’s presentation of evidence from Appellant’s own specification regarding the problem addressed and solved by Appellant’s invention, the Examiner alleges that such remarks “contain no evidence supporting the Appellant’s allegation nor do they address the

merits on Appeal” and that, “[m]oreover this request for consideration as presented by the Appellant is improper for failing to timely and properly submit additional evidence for non-obvious under 37 CFR 1.132 prior to the final office action as set forth by MPEP § 716” (*see* page 13 of Examiner’s Answer).

Taking the latter remark first, Appellant respectfully submits to this honorable Board that Appellant was not introducing “new” evidence to be made of record. Applicant was merely citing to the Appellant’s own specification in response to the Examiner’s arguments. Appellant respectfully submits to this honorable Board that Appellant’s or Applicant’s citations to their own specification during appeal or prosecution, respectively, should not be construed as “evidence submitted to traverse the rejection or objection” noted in 37 CFR 1.132. Were such to be the interpretation of 37 CFR 1.132, an Appellant would, for example, be unable to rely upon their very own specification in an appeal. This position espoused by the Examiner appears facially improper.

As to the Examiner’s statement that the Appellant’s prior remarks “contain no evidence supporting the Appellant’s allegation nor do they address the merits on Appeal,” Appellant’s prior remarks pointed out that Bruzzese’s unitary touch screen (34) does not address the problem addressed and solved by the claimed invention. Appellant acknowledged that, although it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Appellant (*see, e.g., In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), the combination of elements selected from each of the references in combination must have been suggested by or from the references and must intrinsically represent, as a whole, the claimed invention. “[I]t is this invention *as a whole*, and not some part of it, which must be obvious under 35 U.S.C. § 103.”

In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977)(emphasis in original). In this regard, Bruzzese stated a belief that there could be a savings in manufacturing costs when touch screens are used in lieu of the circuitry and components of conventional pushbutton controls (col. 2, lines 18-23) in a mechanical spinning reel machine (i.e., Bruzzese does not disclose or suggest any embodiment of a video portion including player-selectable first indicia selectable via the unitary touch screen). This rationale does not rationally translate to Saffari. While Saffari does disclose an embodiment utilizing mechanical push buttons (*see* FIG. 5), if one of ordinary skill in the art at the time of the invention were to desire to “reduce the device manufacture cost as taught by Cruzzese (Col. 2:18-24),” as alleged by the Examiner (*see, e.g.*, page 4 of Examiner’s Answer), such person of ordinary skill in the art at the time of the invention would simply have turned to Saffari’s embodiment shown in FIGS. 3A-3F wherein the mechanical buttons are eliminated in favor of incorporation of such function within the video monitor and overlying touch screen. Appellant submits that the motivation espoused by Bruzzese and by the Examiner would not motivate the combination of elements recited in Appellant’s claims. Instead, as previously argued by Appellant, the particular rationale for such non-obvious combination is set forth in Appellant’s specification. Appellant again respectfully submits that the particular problem addressed and solved by the claimed invention merits consideration as a potent indicium of non-obviousness.

D. EQUIVALENCE OF BRUZZESE GRAPHICAL ELEMENT NOT ESTABLISHED

In the Examiner’s Answer, in response to the Appellant’s Appeal Brief, the Examiner states that “the teachings of Bruzzese quoted therein clearly recognize the equivalence between video and non-video displays.” (*see* page 15 of Examiner’s Answer).

Appellant respectfully submits that Bruzzese does not “clearly recognize the equivalence between video and non-video displays,” as alleged by the Examiner. As previously noted, in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on Appellant’s disclosure or the mere fact that the components at issue may be functional or mechanical equivalents (which has not been established). *In re Ruff*, 256 F.2d 590 (CCPA 1958). In the present case, Bruzzese states that “[e]ven though video gaming machines utilise more technologically advanced component parts, there still is a significant demand amongst players of gaming machines for the older-style spinning reel machine” and that “[t]he present invention broadly provides a mechanical spinning reel gaming machine that incorporates touch screen controls” (col. 1, lines 30-36). Bruzzese then proceeds to lay out his invention, directed specifically to spinning reel machines with nary a subsequent mention of video embodiments. If, as argued by the Examiner, the video and non-video displays were in fact “clearly equivalent,” then why would Bruzzese note such a disconnect in player preference? Appellant respectfully submits that Bruzzese does not, in fact, recognize the asserted equivalency. Conclusory statements, standing alone, are not “evidence.” *In re Dembiczak*, 175 F.3d 994, 999-1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

2. CLAIMS 4 AND 11 ARE PATENTABLE UNDER 35 U.S.C. §103(A) IN VIEW OF THE COMBINATION OF SAFFARI, BRUZZESE, AND BRIDGEMAN

In the Final Office Action, the Examiner alleged that “[i]t would have been obvious . . . to have incorporated the use of illumination to indicate the availability of a switch to accept inputs as taught by Bridgeman into the option of a touch screen located over artwork as taught by Saffari/Bruzzese in order to direct the user to game inputs only when said inputs are available” (page 4, ¶ 3).

Saffari and Bruzzese are acknowledged not to teach or select “the selective illumination of indicia through lights located behind the artwork panel” (*see* page 5 of Examiner’s Answer). Bridgeman is alleged to make up for this deficiency and is cited to teach “the use of illuminated mechanical switches in order to indicate to a player that a video gaming machine is ready to accept user input.” *Id.* The Examiner concludes and alleges that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the use of illumination to indicate the availability of a switch to accept inputs as taught by Bridgeman into the portion of a touch screen located over artwork as taught by Saffari/Bruzzese in order to direct the user to game inputs only when said inputs are available.” *Id.*

Saffari discloses non-illuminated mechanical buttons and video buttons (*e.g.*, 322a-c in FIGS. 3A-3F or 522a-522c in FIG. 5) provided on a display device 302 (*see, e.g.*, col. 2, line 66 to col. 3, line 10). Saffari does appear to teach that the “touch screen legend” for a column may be blanked-out or de-intensified so that the user is then permitted to select only from the active remaining columns (*see* col. 4, lines 39-43). Bruzzese fails to teach or suggest any illumination for the buttons (not numbered) depicted at the bottom of screen 32 in FIG. 4, let alone behind graphic transfer 36 (*see, e.g.*, col. 3, lines 23-26). Bridgeman discloses the lighting of buttons (*e.g.*, 56, 58, 60, 62, 66) on a front panel of the gaming machine (FIG. 1).

However, none of these references discloses providing selectively illuminated lights behind a touch screen. The Examiner generally casts the problem to be solved as “the use of illumination to indicate the availability of a switch to accept inputs” without considering, as a whole, the context of such a modification. The Examiner picks and chooses specific elements from each of the cited references. The unitary touch screen and permanent player selectable indicia of Bruzzese, the video portion with reel game of Saffari, and the selective lighting of

buttons taught by Bridgeman (or of video buttons taught by Saffari). However, the Examiner never appears to objectively question why one of ordinary skill in the art would make such modification in view of the cited references. For example, Bridgeman teaches the extension of the touch screen for the explicit purpose of reducing the cost of “the cabinet work, circuitry, and components of the conventional pushbutton controls that are replaced.” (col. 2, lines 18-23). The Examiner particularly cites to this teaching of Bruzzese in his allegation that the subject matter of claim 1 would have been obvious. However, the Examiner ignores this very teaching in his allegation that it would have been obvious to one of ordinary skill in the art to then modify Saffari and Bruzzese to then modify the game cabinet to include circuitry and components necessary to provide the selective illumination of lights behind permanent player-selectable indicia on the touch screen. This is a contradiction. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991).

In the present case, Bruzzese and Bridgeman are at odds. The Examiner has failed to identify this conflict and has failed to demonstrate that he, as is required, weighed the power of Bruzzese and Bridgeman to suggest solutions to one of ordinary skill in the art. Appellant respectfully submits that this rejection is improper for at least this reason. For example, the Examiner has failed to persuasively explain why would one of ordinary skill in the art would increase the cost of “the cabinet work, circuitry, and components . . . that are replaced,” in view of Bruzzese, to install lights behind the permanent player-selectable indicia on the touch screen

of Bruzzese when the same function may be met, without the added cost, by relying upon the manipulation of legends on the video screen of Saffari as is taught by Saffari? This latter teaching of Saffari is, incidentally, the very same teaching that the Examiner cites on page 17 of the Examiner's Answer in support of the rejection.

As previously stated, the only nexus between the Appellant's claimed subject matter and the applied prior art is the Examiner's statement of rejection. Appellant respectfully submits that the Examiner has not presented clear and particular reasons why a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The Examiner's remarks in the Examiner's Answer (pages 16-17) fail to address this deficiency.

2. CONCLUSION

Based upon the foregoing, Appellant submits that a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. §103 has not been established for lack of the requisite facts and realistic motivation.

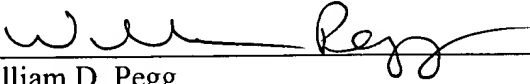
Moreover, upon giving due consideration to the problem addressed and solved by the claimed invention, Appellant respectfully submits that the conclusion appears inescapable that one having ordinary skill in the art would **not** have found the claimed invention **as a whole** obvious within the meaning of 35 U.S.C. §103. *Jones v. Hardy*, 727 F.2d 1524, 220, USPQ 1021 (Fed. Cir. 1984). Appellant, therefore, respectfully submits that the imposed rejections of

claims 1-11 under 35 U.S.C. §103 for obviousness predicated upon the combinations of references noted above are not factually or legally viable.

Based upon the arguments submitted *supra* and previously submitted in the Appellant's Appeal Brief, Appellant respectfully submits that the Examiner has not established a *prima facie* basis to deny patentability to any of the claims under 35 U.S.C. §103. Appellant, therefore, respectfully solicits this Honorable Board to reverse each of the Examiner's rejections.

Respectfully submitted,

Date: April 2, 2007



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